

## **REMARKS**

In the Office Action dated November 19, 2004, claims 1 – 21 stand rejected and claim 5 was objected to. Applicants have herein amended claims 1, 3 – 5, 11, 13, 14, 17, 20 and 21. No new matter is introduced as a result of these amendments, support for which is found within the specification as filed. Applicants respectfully submit that the Examiner's objection and rejections of the pending claims as set forth in the Office Action have been overcome and that claims 1 – 21 now pending in the present application are allowable over the cited art for the reasons set forth below.

### **A. Provisional Double Patenting Rejection**

Claims 1 – 21 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1, 7, 14, 15, 17 and 20 of co-pending Application No. 09/898,365, which is commonly owned with the present application. The pertinent assignment document for co-pending Application No. 09/898,365, a copy of which is attached hereto, has been recorded by the USPTO on microfilm on Reel 012622, Frame 0430. Without acquiescing to the Examiner's grounds of rejection, Applicants file concurrently herewith a terminal disclaimer in accordance with 37 CFR § 1.321(c). Applicants respectfully submit that the filing of the terminal disclaimer overcomes the provisional rejection. Withdrawal of the provisional rejection of claims 1 – 21 based on double patenting is respectfully requested.

### **B. Claim Objection**

Applicants have amended claim 5 to correct the typographic error pointed out by the Examiner. Withdrawal of the informalities objection to claim 5 is respectfully requested.

C. Claim Rejections - 35 U.S.C. §§ 102 and 103

1. 35 U.S.C. § 102

Claim 1 as amended recites:

1. A unitary portable biometrics-based access control device which can be directly plugged into a universal serial bus (USB) socket communicatively coupled to a restricted resource, the device comprising:

a housing;

a microprocessor housed within the housing;

***a USB plug integrated into the housing without an intervening cable and capable of coupling the unitary portable access control device directly to the USB socket;*** and

a biometrics-based authentication module coupled to and controlled by the microprocessor, at least a portion of the biometrics-based authentication module being housed within the housing, wherein access to the restricted resource is granted to a user provided that the biometrics-based authentication module authenticates the user's identity and wherein access to the restricted resource is denied to the user otherwise.

(Emphasis provided).

Claim 1 recites *a unitary portable biometrics-based access control device that can be directly plugged into a USB socket communicatively coupled to a restricted resource*. The claimed device has, among other elements, *a USB plug integrated into the housing of the device without an intervening cable and capable of coupling the device directly to the USB socket*. The claimed device also includes a biometrics-based authentication module, wherein access to the restricted resource is granted to a user provided that the biometrics-based authentication module authenticates the user's identity and such access is denied otherwise. Similarly, claim 11 recites a biometrics-based access control system for controlling access to a restricted resource. The claimed system includes *a portable device that can be directly plugged into a USB socket communicatively coupled to the restricted resource*. The portable device has *a USB plug integrated into its housing without an intervening cable and capable of coupling the device directly to the USB socket*. In the claimed system, the portable device also includes a biometrics-based authentication module configured to implement access control, such that access to the restricted resource is granted upon a successful biometrics-

based authentication and denied otherwise. As for claim 17, a biometrics-based access control method for controlling access to a restricted resource and implemented using a portable device is claimed. One of the claimed steps involves *directly plugging the portable device into a USB socket communicatively coupled to the restricted resource*. The portable device required in the claimed method includes *a USB plug integrated into the device housing without an intervening cable and capable of coupling the portable device directly to the USB socket*. Thus, as amended, these claims in the present application require *a portable device that can be directly plugged into a USB socket communicatively coupled to a restricted resource* and which *has a USB plug integrated into its housing without an intervening cable and capable of coupling the device directly to the USB socket*.

Claims 1, 2, 4, 5, 7, 11, 12, 14, 15, 17, 18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,088,802 (hereinafter “*Bialick*”). Applicants respectfully disagree with the Examiner’s reading of the disclosure in *Bialick*, which in Applicants’ view fails to teach or disclose various claimed limitations of the pending claims as amended. Applicants respectfully submit that *Bialick* does not teach or disclose, among other things, a portable device that can be directly plugged into a USB socket communicatively coupled to a restricted resource and which has a USB plug integrated into its housing without an intervening cable and capable of coupling the device directly to the USB socket, or the use of such a device in an access control system or method, as required by the claims in the present application. Thus, for at least the foregoing reasons, claims 1, 11 and 17, as amended, and the claims dependent therefrom in the present application are not anticipated by *Bialick*.

## **2. 35 U.S.C. § 103 – *Bialick***

Claims 6, 8, 16, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick*. Applicants respectfully disagree with the Examiner’s reading of

the disclosure in *Bialick* and submit that *Bialick* does not render the subject matter of claims 6, 8, 16, 19 and 21 obvious under 35 U.S.C. § 103(a).

The Examiner states that *Bialick* does not disclose a device having a microprocessor configured to provide a bypass mechanism for authentication should the biometrics-based authentication indicates a failed user authentication, as is required by claim 6. The Examiner then suggests that it is obvious to modify *Bialick* to provide a bypass mechanism as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. That *Bialick* indicates it is desirable to establish “a layer of security that protects the integrity of the security operations” (col. 10, lines 50 – 51) does not in any way suggest or motivate the modification proposed by the Examiner. As such, Applicants respectfully maintain that claim 6 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose a device that can provide access control to a communication network, as is required by claim 8. The Examiner then suggests that it is obvious to modify *Bialick* to come up with a device that provides access control to a communication network as claimed in claim 12 and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. That *Bialick* suggests “the peripheral device driver ... can be made available to the host computing device via an appropriate interface (such as a ... network connection)” (col. 9, lines 9 – 11) does not in and of itself suggest or motivate the modification proposed by the Examiner. As such, Applicants respectfully maintain that claim 8 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose providing a bypass mechanism for authentication should the biometrics-based authentication indicates a failed user authentication, as is required in claim 16. The Examiner then suggests that it is obvious to modify *Bialick* to provide a bypass mechanism as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. For the same reason

discussed above in connection with claim 6, Applicants respectfully submit that claim 16 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose storing the registered biometrics marker in an encrypted format, as is required by claim 19. The Examiner then suggests that it is obvious to modify *Bialick* to store the registered biometrics marker in an encrypted format as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully traverse. The generic statement in *Bialick* that it is desirable to enhance the security of the biometrics-based access control method does not in and of itself suggest or motivate the modification proposed by the Examiner. As such, Applicants respectfully maintain that claim 12 is patentable over the cited reference.

The Examiner states that *Bialick* does not disclose providing the user with a bypass authentication procedure when the no match is yielded by the comparison of biometrics markers, as is required in claim 21. The Examiner then suggests that it is obvious to modify *Bialick* to provide a bypass authentication procedure as claimed and that *Bialick* provides the motivation for such modification. Applicants respectfully disagree. For the same reason discussed above in connection with claim 6, Applicants respectfully submit that claim 21 is patentable over the cited reference.

**3. 35 U.S.C. § 103 – *Bialick* in view of *Bjorn***

Claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,799,275 (hereinafter “*Bjorn*”). The Examiner states that *Bialick* does not disclose coupling a portable device to a restricted resource via USB. *Bjorn* is then cited for the proposition that it discloses “... a data bus which conforms to a universal serial bus (USB) standard” (col. 2, lines 59 – 60). The Examiner further suggests that it is obvious to modify *Bialick* to utilize a USB interface and that *Bjorn* provides the motivation to do so. Applicants respectfully disagree and submit that the mere statement in *Bjorn* that a

data bus conforming to the USB standard can be used with the device disclosed therein does not in and of itself suggest or motivate the proposed modification of *Bialick*.

Without acquiescing to the Examiner's reading of the disclosures in both *Bialick* and *Bjorn* or the Examiner's grounds of rejection, Applicants respectfully submit that claims 3 and 13 have been amended herein such that the subject matter in question is no longer recited in amended claims 3 or 13. As such, the rejection has become moot. Applicants further submit that claims 3 and 13 as amended are allowable over the cited art of record.

**4. 35 U.S.C. § 103 – *Bialick* in view of *Burger***

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bialick* in view of U.S. Patent No. 6,219,439 (hereinafter "*Burger*"). Applicants respectfully disagree with the Examiner's reading of the disclosures in both *Bialick* and *Burger* and submit that *Bialick* and *Burger*, alone or in combination, fail to teach or disclose various claimed limitations of claims 9 and 10.

The Examiner agrees that *Bialick* does not disclose a portable device that can provide access control to a real estate premises that imposes access restrictions, as is required by claim 9. *Burger* is then cited for the proposition that it remedies this deficiency. The Examiner further suggests that it is obvious to modify *Bialick* to come up with a device that provides access control to a real estate premises and that *Burger* provides the motivation to do so. Applicants respectfully disagree.

Applicants respectfully submit that there is no motivation for a skilled artisan to combine the teachings in *Bialick* and *Burger*. The law is clear that, before prior art references can be combined, the Examiner must show some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures*,

*Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Nor is the fact that references *can* be combined sufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The Examiner needs to show the additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

There is no suggestion or motivation in either *Bialick* or *Burger* to combine the elements therein. The statement in *Burger* that the apparatus disclosed therein seeks to “provide for an open, stand-alone system” (col. 3, lines 28 – 29) does not in and of itself suggest or motivate the proposed modification of *Bialick*. As such, a skilled artisan would not seek to combine the teachings in the cited art of record to come up with the claimed invention in the present application, and claim 9 is patentable in view of *Bialick* and *Burger*.

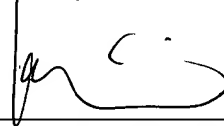
Likewise, with respect to claim 10, the Examiner agrees that *Bialick* does not disclose a portable device that can provide access control to an operable machinery the safe operation of which requires training. Again, *Burger* is cited for the proposition that it remedies this deficiency. The Examiner further suggests that it is obvious to modify *Bialick* to come up with the invention claimed in claim 10 and that *Burger* provides the motivation to do so. Applicants respectfully disagree and submit that there is no suggestion or motivation in either *Bialick* or *Burger* to combine the elements therein. As stated above, the statement in *Burger* that the apparatus disclosed therein seeks to “provide for an open, stand-alone system” (col. 3, lines 28 – 29) does not in and of itself suggest or motivate the proposed modification of *Bialick*. As such, a skilled artisan would not seek to combine the teachings in the cited art of record to come up with the claimed invention, and claim 10 is patentable in view of *Bialick* and *Burger*.

**D. Conclusion**

In view of the foregoing, Applicants respectfully submit that claims 1 – 21 as amended are patentable over the cited art of record. As such, early notification of allowance of claims 1 – 21 is earnestly requested.

The Commissioner is hereby authorized to charge the fees required for the terminal disclaimer and the extension of time under 37 CFR §§ 1.20(d) and 1.136(a), respectively, to White & Case LLP Deposit Account No. 23-1703. Applicants are unaware of any other fees due at this time. However, if other fees are due for any matter concerning this response, the Commissioner is authorized to charge the fees to the above-listed Deposit Account.

Respectfully submitted,



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